REMARKS/ARGUMENTS

In light of the above-amendments and remarks to follow, reconsideration and allowance of this application are requested.

Claims 33, 44, 45 and 55 have been canceled and claims 34-36, 40-43, 46-49 and 52-54 have been amended herein to address minor informalities raised by the Examiner. Claims 56-69 have been added. Accordingly, claims 34-43, 46-54 and 56-59 are presented for consideration.

Claims 33-38, 40-50 and 52-55 have been rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent 6,119,101 (Peckover). Claims 39 and 51 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Peckover in view of U.S. Patent No. 6,307,568 (Rom). Independent claims 33, 44, 45 and 55 have been cancelled and rewritten as new claims 56-59, respectively, to expedite the prosecution of this application. Applicants respectfully traverse these rejections.

Applicants respectfully submit that only the present invention teaches a method for delivering product information and anonymously obtaining market research data based solely on consumer's explicit selections without receiving or collecting information identifying or specific to the consumer to preserve the privacy of the consumer, as required in new independent claim 56 and similarly in new claims 57-59. As admitted by the Examiner, contrary to the present invention, Peckover receives and collects personal information from the consumer. Accordingly, Peckover does not teach or suggest "anonymously receiving one or more product/service criteria for said product/service category from a consumer and at least one of said product/service criteria as a ranking parameter from said consumer, such that no information identifying or specific to said consumer is received or collected," as required in new claims 56-59.

Additionally, Peckover does not teach or suggest searching the product database based solely on consumer's explicit search criteria, as required in new claims 56-59. As admitted by the Examiner, the search query in Peckover is constructed from 1) the template completed by the consumer and 2) consumer preference data collected and stored for that consumer by the Personal Agent 12. Peckover describes that "Query 106 includes data from Product Template 174 completed by the consumer and relevant data from the consumer's preferences, as assembled

by Decision Agent Factory 76." (Office Action, page 3, lines 5-7; Peckover, column 21, lines 58-61). Peckover may potentially narrow the consumer's search by unnecessarily adding search terms to the query. In other words, Peckover searches for what it thinks consumer wants and not what the consumer "really wants." In contrast, the present invention searches anonymously based only on the consumer's explicit search criteria or instruction, thereby insuring an unbiased search for products and services. Moreover, since present invention does not know the identity of the consumer that is performing the search, it is incapable of supplementing the consumer's search criteria with any relevant data from the stored consumer's preferences.

Further, Peckover does not teach or suggest ranking the search results based solely on consumer's explicit order of importance or ranking parameter, as required in new claims 56-59. This enables to present invention to obtain information not only about the search criteria explicitly deemed important by the consumer, but also about the search criteria explicitly deemed most important by the consumer in the query or search (i.e., the ranking parameter). In Peckover, Preference Manager 54 orders the search results "so that items that are more likely to be preferred by the user will be displayed first when the results are delivered to the user." (Peckover, col. 19, lines 18-21). That is, in Peckover, the system orders the search results that the system believes is important to the consumer.

Furthermore, Peckover does not teach or suggest "storing said product/service criteria anonymously received from said consumer and said ranking parameter anonymously received from said consumer as market research data of consumer preferences, thereby anonymously obtaining market research data based solely on consumer's explicit selections without receiving or collecting information identifying or specific to said consumer to preserve the privacy of said consumer," as required in new claims 56-59. Peckover describes storing the activities of the Decision Agent 14 for use as market research data. (see Office Action, page 3, lines 8-9; Peckover, column 21, lines 64-67) "A Decision Agent 14 acts on behalf of a consumer user ... to search out and collect information from Agent System 10 that helps the consumer make purchasing and usage decisions." (Peckover, column 21, lines 25-28) That is, Peckover does not teach or suggest storing consumer's explicit search criteria and ranking parameter for use as market research data of consumer preferences, as required in new claims 56-59. At best,

Peckover describes storing the search results as market research data. It is noted that Peckover describes storing consumer's explicit search criteria by the Personal Agent 12. However, as admitted by the Examiner, in Peckover, the market research data is derived from the Decision Agent 14 and not from the Personal Agent 12 to preserve the privacy of the consumer. (Office Action, page 7, lines 3-7). Therefore, contrary to the clear teachings of Peckover, the Examiner's position requires Peckover to retrieve the data from the Personal Agent 12 (and not from the Decision Agent 14) to obtain the same market research data as the present invention.

Therefore, it is respectfully submitted that Peckover does not teach or suggest any of the elements of the independent claims 56-59 of the present invention.

Of course, a rejection based on 35 U.S.C. §102(e) requires that the cited reference disclose each and every element covered by the claim. *Electro Medical Systems S.A. v. Cooper Life Sciences Inc.*, 32 USPQ2d 1017, 1019 (Fed. Cir. 1994); *Lewmar Marine Inc. v. Barient Inc.*, 3 USPQ2d 1766, 1767-68 (Fed. Cir. 1987), *cert. denied*, 484 U.S. 1007 (1988); *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir.), *cert. denied*, 484 U.S. 827 (1987). The Federal Circuit has mandated that 35 U.S.C. §102 requires no less than "complete anticipation ... [a]nticipation requires the presence in a single prior art disclosure of all elements of a claimed invention arranged as in the claim." *Connell v. sears, Roebuck & Co.*, 772 F.2d 1542, 1548, 220 USPQ 193, 198 (Fed. Cir. 1983); *See also, Electro Medical Systems*, 32 USPQ2d at 1019; *Verdegaal Bros.*, 814 F.2d at 631.

In view of the foregoing differences and authorities, it is respectfully submitted that Peckover does not anticipate or render obvious the invention as recited in claims 33, 44, 45 and 55, and therefore, claims 33, 44, 45 and 55 are patentably distinct over this prior art. The allowance of claims 33, 44, 45 and 55 is respectfully solicited for the reasons given above.

Since claims 34-43 and 46-54 depend from claims 33 and 45, the foregoing discussion of claims 33 and 45 is equally applicable to claims 34-43 and 46-54 and the allowance of claims 34-43 and 46-54 is respectfully solicited for the reasons given above with respect to claims 33 and 45.

Furthermore, Rom relates to an automatic system and a method for fitting articles of clothing on a real image of the user. But, Rom is not suggestive of a method for delivering

product information and obtaining consumer preferences "without storing or maintaining information identifying or specific to the consumer to preserve the privacy of said consumer," as required in claims 33, 44, 45 and 55. Additionally, Rom is not suggestive of storing the search criteria and the ranking parameter selected solely by the consumer as market research data. Further, Rom is not suggestive of storing consumer's selection of one or more product(s) or service(s) from the search result list as market research data of consumer preferences while preserving the privacy of the consumer. These, of course, are features recited by independent claims 33 and 45 (and thus included in dependent claims 39 and 51) and not found in Peckover. Hence, the addition of Rom does not cure the aforenoted deficiencies of Peckover.

Moreover, to establish a prima facie case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant' s disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); MPEP 2143.

The Examiner has failed to establish a prima facie case of obviousness because the combination of Peckover and Rom does not teach or suggest all the claim limitations of independent claims 33 and 45.

Statements appearing above in respect to the disclosures in the cited references represent the present opinions of the Applicant's undersigned attorney and, in the event that the Examiner disagrees with any of such opinions, it is respectfully requested that the Examiner specifically indicate those portions of the references providing the basis for a contrary view.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 50-0624, under Order No. NY-JONAS 203.1 US (10103964) from which the undersigned is authorized to draw.

Respectfully submitted,

By 

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